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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,551	12/11/2001	Keith D. Allen	R-227	4290

7590 02/26/2003

DELTAGEN, INC.  
740 Bay Road  
Redwood City, CA 94063

EXAMINER

NGUYEN, QUANG

ART UNIT	PAPER NUMBER
1636	6

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/015,551	ALLEN, KEITH D.
	Examiner Quang Nguyen, Ph.D.	Art Unit 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) \_\_\_\_ is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-32 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_

## DETAILED ACTION

Claims 1-32 are pending in the present application.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 13-14, 27-28, drawn to a targeting construct for a brain-specific membrane-anchored protein (BSMAP), method of producing the targeting construct, an isolated cell comprising a disruption in a BSMAP gene and methods of identifying an agent that modulates the expression or the function of a BSMAP gene using the same cell, classified in class 435, subclasses 320.1, 455, 463, 4.
- II. Claims 1-12, 15, 17-26 and 30, drawn to drawn to a targeting construct for a brain-specific membrane-anchored protein (BSMAP), method of producing the targeting construct, a non-human transgenic animal or mouse comprising a disruption in a BSMAP gene, an isolated cell derived from the same transgenic animal or mouse (encompassed by claims 5-7), and methods of producing the same transgenic mouse, and methods for identifying an agent that modulates the expression or the function of a BSMAP gene using the same transgenic animal or mouse or cells derived from the same, classified in class 435, subclasses 320.1, 455, 463, 4; class 800, subclasses 8, 18, 3, 21.

- III. Claims 16 and 29, are drawn to an agent identified by the methods of the presently claimed invention, can not be classified because the chemical nature of the identified agent has not been disclosed. Furthermore, depending on the nature of the identified agent, further group restrictions will be required.
- IV. Claim 31, drawn to an agonist or antagonist of a BSMAP receptor, can not be classified because the chemical nature of the agonist or antagonist is not disclosed. Furthermore, depending on the nature of the identified agonist or antagonist, further group restrictions will be required.
- V. Claim 32, drawn to phenotypic data associated with the transgenic mouse of the presently claimed invention wherein the data is in a database.

The inventions are distinct, each from the other because of the following reasons:

The cell comprising a disruption in a BSMAP gene of Group I, the non-human transgenic animal of mouse comprising a disruption in a BSMAP gene of Group II, the agent identified of Group III, the agonist and antagonist of a BSMAP receptor of Group IV, and the phenotypic data in a database of Group V are chemically, physically and structurally distinct one from the others. It is further noted that a cell comprising a disruption in a BSMAP gene of Group I can be made by means other than generating a transgenic non-human animal or mouse of Group II, for example via a simple homologous recombination in any cell using a targeting construct specific for BSMAP. Similarly, methods of uses in Group I differ from those of Group II because they involve different starting materials, different method steps and different technical considerations

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for attaining different desired end-results. Additionally, the identified agent of Group III is not necessarily the same as the agonist or antagonist of a BSMAP receptor of Group IV because none of the chemical structures for any identified agent, BSMAP receptor agonist or BSMAP antagonist has been disclosed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and separate search requirements, it would be unduly burdensome for the examiner to search and/or consider the patentability for all of the inventions in a single application. Therefore, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Gerald Leffers, Jr., Ph.D., may be reached at (703) 305-6232, or SPE, Remy Yucel, Ph.D., at (703) 305-1998.

Quang Nguyen, Ph.D.

*Gerald B. Leffers Jr.*  
PATENT EXAMINER  
*Gerald B. Leffers Jr.*  
A.U.1636